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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/392,270	09/09/1999	JASON A. POIRIER	1-21036	9927

27210 7590 04/28/2003

MACMILLAN, SOBANSKI & TODD, LLC
ONE MARITIME PLAZA - FOURTH FLOOR
720 WATER STREET
TOLEDO, OH 43604

EXAMINER	
NGUYEN, TRINH T	
ART UNIT	**PAPER NUMBER**
3726	22

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/392,270	Poirier et al.
Examiner	**Art Unit**
Trinh Nguyen	3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Dec 23, 2002* .

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above, claim(s) *8-14* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-7, 15, and 16* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7, 15, and 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-20 of copending Application No. 09/408,747. Specifically, claim 11 of the commonly assigned 09/408,747 "anticipates" the application claim 1. Accordingly, the application claim 1 is not patentably distinct from the commonly assigned 09/408,747 claim 11, since claim 11 requires elements A, B, C, and D while claim 1 only requires elements A and B. Thus it is apparent that the more specific claim 11 encompasses claim 1. Following the rationale in In re Goodman cited in the preceding paragraph, where applicant has once been filed an application or granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second

application or patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Commonly assigned 09/408,747, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78© and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 1-7, 15, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Applicant's Admitted Prior Art** (as set forth in lines 13-29 of page 1, all of pages 2 & 3, lines 1-10 of page 4, lines 19-24 of page 6, lines 1-22 of page 7, lines 16-26 of page 8, and lines 22-25 of page 9; hereinafter is referred to as **AAPA**) in view of **Mills et al.** (US 4,362,578).

AAPA discloses that it is old and well known to manufacture a vehicle frame structure by: providing a closed channel workpiece member; performing a retrogression heat treatment process to softening the workpiece member; and while the workpiece remains softened, deforming the workpiece member to form a vehicle frame structure (see lines 17-28 of page 3 of the specification). Further note that the use of inductive heating coil and quenching ring are well known and conventional as admitted by the Applicants in lines 18 & 19 of page 8 and line 23 of page 9.

AAPA teaches the claimed invention except to mention that when performing the heat treatment process on the workpiece the inductive heating coil and the quenching ring are moved in a continuous and longitudinal manner from one end of the workpiece to the other end.

Mills et al., on the other hand, teach a method of hot working metal workpieces by using inductor heating coil to heat the workpieces into a desirable temperature, and at the same time softening the workpieces. Mills et al.'s method further allow the metal workpieces to be moved in a continuous and longitudinal manner through the heating coil so as to vary the rate of heat

along the length of the workpieces (see lines 3-40 of col. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Mills so as to include the use of induction heating coil assembly in which the workpiece can be heated in a continuous and longitudinal manner, as taught in Mills, in order to vary the rate of heat along the length of the workpiece and also to easily and economically deform a workpiece member due to its low and/or high threshold temperatures.

Regarding claims 4-7, AAPA sets forth the invention as cited above with the exception of the orientation of the workpiece. It would have been obvious to one of ordinary skill in the art at the time the invention was made that whether the heat treatment process is performed by suspending and/or supporting the workpiece member vertically or horizontally by an upper end and/or lower end is a matter of design choice since no significant problem is solved or unexpected result obtained by supporting the members in the orientation claimed versus that taught by the prior art.

It is noted that the Applicants recite specific article design limitations in claims 15 and 16, i.e., specific material limitations, however, such limitations must result in a manipulative difference in the recited process steps as compared to the prior art. In this instance these design limitations are held to be obvious and not given patentable weight in these method of manufacturing claims as such limitation(s) do not result in any difference in the *claimed* manufacturing process.

Response to Arguments

6. Applicant's arguments filed 12/23/02 have been fully considered but they are not persuasive.

7. In response to Applicant's argument that Mill et al.'s heat treatment process is different from the claimed retrogression heat treatment process, it is noted that the Mill et al. reference was merely cited to show that it is old and well known to heat treating metal workpieces by using inductor heating coil to heat the workpieces into a desirable temperature, and at the same time softening the workpieces, and that the metal workpieces are allowed to be moved in a continuous and longitudinal manner through the heating coil so as to vary the rate of heat along the length of the workpieces (see lines 3-40 of col. 3). Furthermore, as shown in lines 17-28 of page 3 of the specification, it is noted that the retrogression heat treatment process as claimed is old and well known heat treatment process.

Conclusion

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Trinh Nguyen** whose telephone number is **(703) 306-9082**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

ttn

April 24, 2003

GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700